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REMARKS

Specification

The specification stands objected to because it contains an embedded hyperlink. In accordance with the Examiner's suggestion, applicants have added left and right brackets around the hyperlink to deactivate it.

Claims

Claims 1-27 are in the application. Claims 1, 12, 17, and 25 are in independent form. Claims 25-27 are added by this amendment.

Overview of Differences Between Preferred Embodiments and Wang

Wang describes a system that adds machine-readable information to a document so that the document can be automatically processed. Wang's system processes two categories of documents: documents that include pre-printed machine readable information, and documents that do not include machine readable information. Col. 4, lines 40-54. For documents that do not include machine-readable information, manual indexing is required, that is, a person must intervene in the process to read the document and manually enter information describing the document. Col. 4, lines 43-46. The document is then reprinted with the indexing information in machine-readable code printed on the document.

Wang's second category, documents that include pre-printed machine-readable information, include tax returns (FIG. 10), medical note pads (FIG. 7), checks (FIG. 9) and identification cards (FIG. 8). The form image can be scanned and stored, with the machine-readable data indicating what the data is and how to store it.

Wang requires manual intervention to process documents that do not include preprinted machine-readable identification. On the other hand, in a preferred embodiment of applicants' system, documents without machine readable code, such as transcripts from third parties, are

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indexed and stored without requiring manual intervention, thereby providing a significant benefit over Wang et al.

Because applicants accomplished something that Wang does not, the steps described and claimed by applicants are different from the steps described in Wang, even though both Wang and applicants send and receive documents and use facsimile machines.

New claim 25 explicitly recites "without manual intervention" and "the printed form lacking identifying information encoded in machine-readable form."

Anticipation Rejections

Claims 17, 19, and 20 stand rejected under 35 USC 102(b) as anticipated by U.S. Pat. No. 5,490,217 to Wang et al. Applicant responds as follows.

While different embodiments described in Wang include individual steps of transmitting various types of documents, Wang does not teach an embodiment that performs the steps of claim 17, 19, or 20. For example, the Examiner cites col. 3, line 6-9, to show that Wang teaches receiving information in electronic form over a network. Col. 3, lines 10-16, make clear that this is in the context of receiving a document that includes machine-readable information. The Examiner then cites col. 6, line 59-61, for transmitting a document in printed form to a second source. Col. 6, lines 59-61, are in the context of an electronic notary and describes transmitting a document without machine-readable information to a third party as shown in FIG. 11. The examiner cites FIG. 1 and FIG. 2 for showing receiving facsimile information, and then returns to the Summary of the Invention section, col. 2, lines 7 and 30-32 to show other steps.

To support an anticipation rejection, the elements in the reference must be arranged as they are in the claim. MPEP 2131. Applicants submit that it is improper to pick and chose steps from different embodiments in a reference to support an anticipation rejection. If the reference does not teach the claimed invention in a single embodiment, the reference does not anticipate the invention. Applicants submit that the methods of claim 17, 19 and 20 are not taught by Wang respectfully requests that the anticipation rejection be withdrawn.

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Moreover, not all the elements of claims 17, 19, and 20 are taught by Wang. While Wang teaches transmitting and receiving information, it does not teach the specific claimed interactions between the entity performing the claim steps and the two sources. For example, in the electronic notary embodiment of Wang, which processes documents that do not include machine readable identifying information, a paper document without a machine-readable code is sent by a first party to a second party, who applies a machine-readable code and transmits it back to the first party. There is no first and second source of information. Applicants submit that Wang neither anticipate nor makes obvious claims 17, 19 and 20.

The differences between Wang and claim 17, 19, and 20 are not trivial: Wang's method requires manual indexing of documents that not have machine readable information pre-printed on them, and applicants' method permits the elimination of manual indexing.

Obviousness Rejections

Claims 1, 6-10, 12, 13, 15, 16, 22, and 24 stand rejected under 35 U.S.C. § 103 for obviousness over Wang in view of U.S. Pat. App. Publ. No. US2001/0011246 A1 to Tammoro ("Tammoro") and Webster's II New College Dictionary ("Websters").

On page 4 of the Office action, the Examiner states that Wang discloses a method of "transmitting" and "receiving" a document over a computer network, but fails to teach "applications for admissions to institutions," which is supplied by Tammoro. As describe above with respect to claims 17, 19, and 20, Wang teaches sending documents back and forth but does not teach the specific interaction between parties as claimed in independent claims 1 and 12.

The Examiner states that Wang anticipates "automatically transmitting to a third party via facsimile a request for a document to be associated with the application." The Examiner cites FIG. 1 as showing that Wang uses a facsimile machine. Wang teaches using a fax machine to send a document that already has machine readable code printed on it (Col. 4, line 54-57.) Wang also teaches using a fax machine in his "electronic notary" embodiment, col. 6, line 55- col. 7, line 3. In this embodiment, someone faxes a document already in his or her possession to the

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electronic notary service to have the document marked with machine-readable encoding and returned. The encoded document can then be verified by another by faxing it back to the notary for confirmation. The encoding is used to verify the authenticity of the document, not to connect it with another document. There is no request to a third party for a "document to be associated with the application" as recited in claim 1.

As for "receiving from the third party as facsimile data the document along with machine readable identifying information indicating the application to which the document is to be associated," the Examiner again references Wang's "electronic notary" embodiment. As described above, the machine-readable information describes the original document; it does not describe "the application to which the document is to be associated." Looking at the invention as a whole and at the problem that applicants solved, Wang combined with Tammaro and Webster does not address the problem and does not teach or suggest applicants' solution.

With regard to independent claim 12, the Examiner states that Wang discloses all the elements except for a "form," which is disclosed in Tammaro. The Examiner does not cite a passage in Wang showing a facsimile transmission device for "transmitting in accordance with an instruction from the server a request for a document to be attached to the form" and applicants submit that Wang does not teach this element because it is outside the purpose of Wang.

Claims 2, 18, and 23 stand rejected under 35 U.S.C. § 103 for obviousness over Wang in view of Tammaro and Webster's and further in view of U.S. Pat. No. 5,659,164 to Schmid et al. ("Schmid"). The Examiner points out that Schmid et al. teaches using a cover sheet with machine-readable data. Applicants submit that Schmid does not provide the elements missing as described above from the independent claims. Moreover, Schmid does not say how the cover sheet is generated. Reading Schmid in light of Wang, one would assume that either an individual must have reviewed the data in the document and manually entered the information to create the cover sheet, or the cover sheet was created with the document. In either case, Schmid et al. does not provide the elements missing from the independent claims as described above.

Claim 5 and 21 stand rejected under 35 U.S.C. § 103 for obviousness over Wang in view

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of Tammaro and Webster's and further in view of U.S. Pat. No. 5,853,197 to Mowry Jr. et al. ("Mowry"). Applicants submit that Mowry does not provide the elements described above as missing from the corresponding parent claims.

Claims 11 and 14 stand rejected under 35 U.S.C. § 103 for obviousness over Wang in view of Tammaro and Webster's and further in view of U.S. Pat. No. 5,089,956 to MacPhail. The Examiner states that MacPhail discloses transmitting documents at two different times. Applicants submit that the cited passage in MacPhail does not teach that "documents are transmitted at different times to the institution and the identifying information is used to match the document with the application." The passage states: "After the dialogue manager application 14 has gathered the above-identified information, it transmits the information to the request application program 16." The dialogue manager application 14 is not transmitting documents; it is only managing the interface with the end user. As described in col. 3, line 68-col. 4, line 14, the requester's server transmits the documents to the recipient's server, and the recipient is given a notice in his mail queue. Thus the word "after" in the cited passage does not show that one documents is being transmitted after another, only that a dialogue manager collects information about the end users and the documents before the documents are collected and transmitted by the application program 16 and the requester server 18.

Applicants submit that the claims are patentable over the art of record and respectfully requests reconsideration and allowance of the application be allowed.

Respectfully submitted,

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